

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH L. TATE and HELEN B. TATE

Appeal No. 96-3032
Application No. 08/321,392¹

ON BRIEF

Before CALVERT, MEISTER and FRANKFORT, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

¹ Application for patent filed October 11, 1994. According to appellants, this application is a continuation-in-part of Application 08/093,605 filed July 19, 1993, now abandoned.

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Joseph L. Tate and Helen B. Tate (the appellants) appeal from the final rejection of claims 2-4, 7, 8², 10-12, 15, 18, 19 and 22. Claims 6, 14 and 21, the only other claims present in the application, stand allowed.

We AFFIRM.

The appellants' invention pertains to a mounting corner usable with other like mounting corners for the purpose of mounting photographs or posters on a vertical surface such as a wall. Independent claim 2 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Murray	1,194,217	Aug. 8, 1916
Tannenbaum	4,837,953	Jun. 13, 1989
Taylor	4,838,793	Jun. 13, 1989

² Page 3 of the brief states that claim 8 has been canceled; however, as the examiner has noted on page 3 of the answer, no cancellation of this claim has in fact been made.

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Claims 2-4, 8, 10-12, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murray in view of Taylor.³

Claims 2-4, 7, 10-12, 15, 18, 19 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murray in view of Tannenbaum.

The arguments of the appellants and examiner in support of their respective positions may be found on pages 16-42 of the brief and pages 6 and 7 of the answer.

OPINION

At the outset we note that the appellants have not separately argued the patentability of dependent claims 3, 4, 8, 11, 12 and 19 with any reasonable degree of specificity. Accordingly, these claims fall with the claims from which they depend. ***In re Nielson***, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and ***In re Schrader***, 22 F.3d 290, 292 n.3, 30 USPQ2d 1455, 1456 n.3 (Fed. Cir. 1994). Note also

³ Although claim 9 has been included in this rejection on page 4 of the answer, we note that this claim has been canceled (see Paper No. 9).

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that as expressly set forth in 37 CFR § 1.192(c)(7): "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable."

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and all of the respective arguments advanced by the appellants in the brief and by the examiner in the answer. As a consequence of this review, we will sustain both of the above-noted rejections.

Initially we note that while the obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination (*see, e.g., ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)), this does not mean that the cited references or prior art must specifically suggest making the combination (*B.F. Goodrich Co. V. Aircraft Braking Systems Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Instead, obviousness may be

established by what the combined teachings of the references would have suggested to those of ordinary skill in the art. ***In re Young***, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)⁴. Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (***In re Preda***, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)), and all of the disclosures in a reference must be evaluated for what they fairly teach one having ordinary skill in the art (***In re Boe***, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966)).

⁴ More specifically, as stated by the court in ***Keller***, 642 F.2d at 425, 208 USPQ at 881:

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

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Considering now the rejection of claims 2-4, 8, 10-12, 18 and 19 as being unpatentable over Murray in view of Taylor, it is the examiner's position that:

The reference to Murray discloses a triangular shaped picture holder having a slot for receiving the edge of the picture to be supported and a pin 15 for securing the holder on a supporting surface.

The reference to Taylor discloses a plastic holder (column 2, lines 61, 62) for a display sheet having a magnetic strip 13 adhesively secured . . . to the rear surface for the purpose of attaching the holder and display sheet to a ferrous surface such [as a] metal . . . backed chalkboard or a refrigerator door. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted in Murray for his securing means 15 a magnetic strip adhering means as taught by Taylor at 13 [in order] to achieve Taylor's expressly stated advantage of ease of securement to a ferrous surface such as metal backed chalkboard or refrigerator door.

The material from which a device is made, its dimension as well as the method of making are considered as obvious matters of engineering choice. Note that Murray recites that the device can be made of any suitable materials and of any dimension (lines 54, 55, and 66, 67). As to [the] specific shape of the magnets this is considered to be the work of a skillful mechanics [sic, mechanic]; further no advantage but for aesthetic [purposes] is seen in making the magnets elongated, triangular, square, etc. [Answer, pages 4 and 5.]

It is the appellants' contention that there is no suggestion to combine the teachings of Murray and Taylor in

the manner proposed by the examiner. This is particularly the case, in the appellants' view, because Murray "cannot possibly represent a proper and sufficient basic reference" (brief, page 18) since (1) the corners are not constructed of a relatively thick, rigid material, (2) there is no mention therein of magnetic material, much less triangularly-shaped magnetic material, (3) the sole mounting means disclosed is a stick pin 15, (4) there is no mention therein of mounting to a ferrous surface and (5) it is improper to **"endeavor to impute a supposed purpose of the secondary reference, the Taylor patent, into a device (Murray) that clearly is quite unable to utilize same"** (brief, page 22). It is also the appellants' contention that "the Taylor patent teaches magnetic material only in the configuration of an elongate strip 13 that has been sandwiched between pieces of sheet material" (brief, page 20).

We are unpersuaded by the appellants' arguments. First, we observe that the appellants' contentions regarding the teachings of Taylor are simply factually incorrect. That is, while Taylor does teach an elongate strip of magnetic material

13 sandwiched between two sheets 11 (see Fig. 3) for the purpose of securing the sheets to a ferrous surface, this is not "only" what Taylor teaches as the appellants would have us believe. Taylor, after initially stating that the magnetic strip may be secured "on a backside for the purpose of holding said sheet to a ferrous base surface" (column 1, lines 64-66), also expressly states that, although two sheets are "preferred," a **single** sheet may be used (column 2, line 35). Additionally, Taylor **also** teaches that other display articles 16 of various irregular shapes may be provided with "flexible magnetic means 17 adhered to its bottom" (see column 3, lines 6-9; note Fig. 4 wherein the entire bottom or rear surface of the display article 16 is provided with flexible magnetic means 17) to likewise hold these irregularly-shaped display articles.

As to the question of combining the teachings of Murray and Taylor, it is true that there is no mention in Murray of magnetic material or of a ferrous surface, and that Murray's stick pin 15 does not appear to have the ability to be attached to a ferrous surface. Nevertheless, Taylor teaches

that magnet material attached to the rear surface of a display article (either a sheet 11 or an irregularly shaped display article 16) may advantageously be employed in order to hold such articles on a ferrous surface such as a refrigerator door or metal-backed chalkboard (see column 2, lines 44, 45). In applying the test for obviousness set forth in footnote 4, we are of the opinion that one of ordinary skill in this art would have found it obvious to substitute in Murray for the pin-type fastening 15 a magnetic fastening means (either 13 or 17) as taught by Taylor in order to achieve the advantage of being able to attach Murray's holder to a ferrous surface.

As to the appellants' contention that there is no teaching in Murray of making the holder of a relatively thick, rigid material, we note artisans must be presumed to know something about the art apart from what the references disclose (***see In re Jacoby***, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (***see In re Bozek***, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is

presumed on the part of those practicing in the art. **See In re Sovish**, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). With these principles in mind we note that, although Murray only states that his mounting corner may be constructed "from any suitable material" (lines 54 and 55), Murray's mounting corner is provided with a relatively large stick pin 15 on the rear surface thereof and is intended to mount a picture (which includes a "glass covering" - see lines 71-72) on a wall of a structure (see line 57). Therefore, we perceive that the artisan as a matter of common sense would make Murray's mounting corner of a relatively thick, rigid material so as to provide adequate support for the transmission of the force created by the relatively heavy glass-covered picture to the wall via the stick pin 15. While the appellants have attempted to distinguish the decisions in **Jacoby**, **Bozek** and **Sovish** based upon their particular fact situations, we are of the opinion that the principles set forth therein are equally applicable to the instant fact situation.

Although the appellants note that neither Murray nor Taylor teach triangularly-shaped magnetic material (claims 2 and 10) or magnetic material "approximately the size of" the triangularly-shaped rear member (claim 18), they do not appear to dispute the above-noted position of the examiner that the "specific shape of the magnets . . . is considered to be the work of a skillful mechanics [sic, mechanic]; further no advantage but for aesthetic [purposes] is seen in making the magnets elongated, triangular, square, etc." In any event, the above-noted statement by Taylor in lines 6-9 of column 3 that the flexible magnetic means is adhered to the "bottom" of the irregularly-shaped display articles 16 and the showing in Fig. 4 that the entire bottom or rear surface of the display article 16 is provided with the flexible magnetic means 17, would have fairly suggested to the artisan (when substituting a magnetic-type securing means as taught by Taylor for the pin-type securing means of Murray) to provide the magnetic-type securing means over the entire triangularly-shaped rear surface of Murray's holder, thus making the magnetic-type securing means triangular in shape. Moreover, we are of the opinion that one of ordinary skill in this art, when providing

Murray's holder with a magnetic securing means in accordance with the teachings of Taylor, would as a matter of common sense cover the entire rear surface of Murray's holder with the magnetic-type securing means in order to adequately support Murray's relatively heavy glass-covered picture.

In view of the foregoing, we will sustain the rejection of claims 2-4, 8, 10-12, 18 and 19 under 35 U.S.C. § 103 based on the combined teachings of Murray and Taylor.

Turning to the rejection of claims 2-4, 7, 10-12, 15, 18, 19 and 22 under 35 U.S.C. § 103 as being unpatentable over Murray in view of Tannenbaum, it is the examiner's position that:

The patent to Tannenbaum discloses a plastic holder for photographs having three members (2, 3, 4 in Fig. 2) secured together in such a manner so as to form a slot 5 [sic] for the reception of a photograph. Tannenbaum also provides a magnetic strip 11 attached to the rear surface of his holder so it can be secured to a vertical magnetic surface, such as a door of a refrigerator or freezer (see column 3, lines 14-16). As to claims 2-4, 10-12, 18 and 19, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substituted [sic, substitute] in Murray for his securing means 15 a magnetic strip adhering means as taught by Tannenbaum at 13 [in order] to achieve Tannenbaum's expressly stated advantage of ease of securement to a ferrous surface such as the door of a refrigerator or freezer. As to claims 7,

15 and 22, [i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the mounting corner of Murray of three pieces joined together as taught by Tannenbaum [in order] to achieve Tannenbaum's self evident advantage of ease of construction. As to [the] specific shape of the magnets this is considered to be the work of a skillful mechanics [sic, mechanic]; further no advantage but for aesthetic [purposes] is seen in making the magnets, elongated, triangular, square, etc. [Answer, pages 5 and 6.]

The appellants argue at great length that the embodiment of Figs. 1-3 of Tannenbaum only discloses an adhesive securing means and that the only embodiment of Tannenbaum which has a magnetic securing means is the embodiment of Fig. 4. We are at a complete loss, however, to understand why the appellants believe that the teachings of Tannenbaum should be limited only to the teachings of Figs. 1-3. The examiner has relied upon the embodiment of Fig. 4 for a showing of a magnetic securing means 11 which secures a photograph displaying device to the door of a refrigerator or freezer. While the examiner has relied on the embodiment of Figs. 1-3 for a teaching of a three-piece photograph displaying device having a groove for receiving the photograph, a limitation which requires the claimed photograph mounting or display device to be formed of

three pieces is found only in claims 7, 15 and 22. Even with respect to these claims, however, we observe that independent claim 1 of Tannenbaum is directly readable on the embodiment of Figs. 1-3 and has dependent thereon (a) claim 4 which recites that the securing or attaching means is "tacky synthetic material" and (b) claim 5 which recites that the securing or attaching means is a "magnet." Accordingly, claims 1, 4 and 5 of Tannenbaum, taken as a whole, would fairly suggest to the artisan that either (a) an adhesive securing or attaching means or (b) a magnetic securing or attaching means may be used with the embodiment of Figs. 1-3.

The appellants contend that there is no suggestion in Murray of a triangularly-shaped magnetic securing means, but do not specifically address the above-noted position of the examiner that the "specific shape of the magnets . . . is considered to be the work of a skillful mechanics [sic, mechanic]; further no advantage but for aesthetic [purposes] is seen in making the magnets, elongated, triangular, square, etc." In any event, we are of the opinion that one of ordinary skill in this art, when providing Murray's holder with a magnetic securing means in accordance with the

teachings of Tannenbaum, would as a matter of common sense cover the entire rear surface of Murray's holder with the magnetic-type securing means in order to adequately support Murray's relatively heavy glass-covered picture.

With respect to claims 7, 15 and 22, the appellants appear to contend that Tannenbaum does not teach a mounting member formed of three pieces. However, as noted by the examiner, Tannenbaum teaches first and second members 2,3 which are spaced apart by a thick adhesive portion 4 in order to form a groove or slot 5 for the reception of a photograph or picture (much as the appellants' member 32 spaces apart members 30, 34 in order to form a slot or groove for the reception of a photograph or poster). Giving the terminology of claims 7, 15 and 22 its broadest reasonable interpretation,⁵ we share the examiner's view that the members 2 and 3 and the thickened adhesive portion 4 can collectively be considered "three pieces" as claimed.

⁵ **See *In re Morris***, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and ***In re Zletz***, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

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In view of the above, we will sustain the rejection of claims 2-4, 7, 10-12, 15, 18, 19 and 22 under 35 U.S.C. § 103 based on the combined teachings of Murray and Tannenbaum.

In summary:

The rejection of claims 2-4, 8, 10-12, 18 and 19 under 35 U.S.C. § 103 based on the combined teachings of Murray and Taylor is affirmed.

The rejection of claims 2-4, 7, 10-12, 15, 18, 19 and 22 under 35 U.S.C. § 103 based on the combined teachings of Murray and Tannenbaum is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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Julian C. Renfro
P.O. Box 2601
Winter Park, FL 32790-2601